

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 31

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte KIYOSHI OHMORI, SUNAO AOKI, TAKAKIYO KANAZAWA,
and TAKATSUGU FUNAWATARI

Appeal No. 2001-1574
Application No. 08/856,050

HEARD: July 10, 2001

Before HAIRSTON, FLEMING, and BLANKENSHIP, Administrative Patent Judges.
BLANKENSHIP, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1-7, which constitute all the claims remaining in the application.

We reverse.

BACKGROUND

The invention is directed to a disc cassette in which a recording disc is rotatably received. The cassette has a slide bar connected to a shutter which is arranged to be opened to provide access to heads for reading from or writing to the recording disc.

Representative claim 1 is reproduced below.

1. A disc cassette for use in a disc player having a head carriage, the cassette comprising:

a case receiving a rotatable disc recording medium and having an opening through which an information recording area of said medium is exposed;

a bridge defined by said case and formed in a front surface thereof extending across a mouth portion of said opening parallel to said front surface of said case and being offset therefrom in a direction toward a center of said disc recording medium;

a slide bar having a width in a direction perpendicular to a top surface of said disc smaller than a width of said case in said direction perpendicular to the top surface of said disc and slidably mounted beside said bridge for moving axially therealong; and

a shutter connected to said slide bar for moving therewith to selectively open and close said opening in accordance with axial movement of said slide bar, wherein a front surface of said shutter is flush with said front surface of said case, and wherein when said shutter is moved to open said opening, said front surface of said shutter forms a continuous line along said front surface of said case with an edge of said case, and

wherein said slide bar has a base portion which overlaps an entire length of said bridge when said shutter is in an open position, said base portion being formed with a recess which faces in a direction away from a center of said disc recording medium and adapted to mate with a front face of said head carriage of said disc player when said head carriage comes to its innermost position, and wherein said recess is defined between a front surface of said base portion of said slide bar and said front surface of said shutter, thereby increasing a stroke

of the head carriage in an inward radial direction of said disc recording medium when said shutter is in said open position.

The examiner relies on the following reference:

| | | |
|---------|-----------|---------------|
| Akiyama | 5,444,691 | Aug. 22, 1995 |
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Claims 1-7 stand rejected under 35 U.S.C. § 103 as being unpatentable over appellants' admitted prior art (disc cassette, shown in Figures 9A and 9B of the disclosure) in view of Akiyama.

We refer to the Final Rejection (mailed Nov. 12, 1998) and the Examiner's Answer (mailed Jun. 18, 1999) for a statement of the examiner's position and to the Brief (filed Apr. 9, 1999) for appellants' position with respect to the claims which stand rejected.

OPINION

The examiner finds (Answer at 4) that the difference between the prior art disc cassette, as shown in Figures 9A and 9B of appellants' disclosure, and the claimed invention is the recess in the base portion of the slide bar (or the "projection/gap configuration," relevant to claims 4-6). The examiner points to Figures 27 and 28 of Akiyama for an "unnumbered" recess "in the front surface of the slide bar." The examiner concludes (id. at 4-5) that the claimed subject matter would have been obvious because the artisan would have recognized that providing such a recess would

facilitate proper head loading and prevent the head carriage from contacting the front surface of the slide bar.

Appellants argue (Brief at 5) that the “unnumbered recess” shown in Figures 27 and 28 of Akiyama is not formed in a slide bar, but in the cassette case. Appellants further argue (id. at 6-7) that the prior art lacked suggestion to make a combination such as that proposed.

The examiner responds (Answer at 5) that even if Akiyama may be regarded as failing to disclose a recess in a slide bar, the reference shows a recess in “the structure most external to the cartridge” at least in Figures 4, 27, and 28. “One of ordinary skill would have realized that a recess in the slide bar would have increased the stroke of a head carriage.” (Id.)

The examiner also refers, on page 7 of the Answer, to another patent to an entity of “Akiyama et al” and a publication of “Kato,” which are alleged to support an ancillary position with regard to “miniaturization” being a design goal in the art. However, the two alleged references have not been properly submitted as evidence to show unpatentability, are not before us, and have not been reviewed by us. The patent and publication noted by the examiner are thus, in effect, irrelevant with respect to whether or not the instant rejection is proper.¹

¹ We note that, should references be relied upon in a response to an appellants’ arguments, the references should be clearly included in the initial statement of the rejection. See In re Hoch, 428 F.2d 1341, 1342 n.3, 166 USPQ 406, 407 n.3 (CCPA 1970) (“Where a reference is relied on to support a rejection, whether or not in a ‘minor capacity,’ there would appear to be no excuse for not positively including the reference in the statement of rejection.”).

The Akiyama reference that is before us, in the description of Figure 27, refers back to the “slider” shown in Figure 2 for relevant details thereof. Col. 10, ll. 53-68. The description of Figure 28 does not reveal any sliding mechanism which may be different from that common to Figures 2 and 27. See col. 11, ll. 11-22. Akiyama’s Figure 4 is a perspective view showing the disc cartridge from which the slider has been removed. Col. 2, ll. 17-18.

The “slider” described in Akiyama’s embodiment shown in Figure 2 is slider 14. Guide grooves 21, 21 (Figs. 2 and 5) are formed in both sides of slider 14 and are adapted to engage with guide rails 22, 22 (Fig. 2) formed in a guide portion G at the front edge of the cartridge C. Col. 3, ll. 41-45. However, as described by the reference at column 3, lines 26 through 40, slider 14 is fixed to shutter 6 by screws 15, 15 engaged with receiving holes 18, 18 in the slider. Receiving recess 19 (Fig. 2) in the slider matches with pin receiving hole 17 in shutter 6 for receiving opening/closing pin P1 (Fig. 3). Col. 3, ll. 51-64.

In view of the foregoing, we agree with appellants that Akiyama does not disclose a slide bar having a recess as detailed in the instant claims -- with structure such that the slide bar recess is positioned to meet a front face of a head carriage and allow increased head carriage stroke in an inward radial direction of the recording medium.

As for the “unnumbered recess” shown in Figures 4, 27, and 28 of the reference, we also agree with appellants that the rejection appears to be based on improper

hindsight reconstruction of appellants' invention. The examiner has not pointed out, and we do not find, any description in the Akiyama reference with respect to purpose or function of the "recess." Absent a teaching from the prior art that is directed to some reason for placement of the recess, we conclude that the rejection is based on speculation, rather than factual findings supported by evidence in the record. Cf. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (in a determination of unpatentability "the Board must point to some concrete evidence in the record in support of...[the]...findings").

We thus do not sustain the rejection of claims 1-7 under 35 U.S.C. § 103 as being unpatentable over appellants' admitted prior art in view of Akiyama.

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CONCLUSION

The rejection of claims 1-7 is reversed.

REVERSED

KENNETH W. HAIRSTON
Administrative Patent Judge

MICHAEL R. FLEMING
Administrative Patent Judge

HOWARD B. BLANKENSHIP
Administrative Patent Judge

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